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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TAKUYA MATSUMOTO,
SHIRO KIDERA, and
RYUICHI ISHII

Appeal 2008-2210
Application 10/718,660
Technology Center 3600

Decided: January 16, 2009

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Takuya Matsumoto, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the Final Rejection of claims 25-39. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.[1]

THE INVENTION

The claimed invention is directed to "a system and method of arranging delivery of advertisements over a network such as the Internet." Specification 1:8-9. The invention "is capable of arranging the advertisement in such a manner as to satisfy varying requirements of the advertisers for effective return from the advertisements … [and] includes an agent's server provided with an invitation module, an offer module, and an arrangement module." Specification 1:26-2:1.

> The agent's server includes a response measurement module which is programmed to count the number of specific responses made at the advertiser's web site through the ad space. Further, included in the server is an administration module which is programmed to provide a statistical report over the Internet for furnishing the advertiser with an analysis of the responses being counted so that the advertiser can estimate the effectiveness of the advertisement.

Specification 2:25-3:2.

Claim 25, reproduced below, is illustrative of the subject matter on appeal.

> 25. A system of arranging the delivery of advertisements over a network, an agent managing

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[1] Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed Jan. 30, 2007) and Reply Brief ("Reply Br.," filed Nov. 14, 2007), and the Examiner's Answer ("Answer," mailed Jul. 6, 2007).

said system, said system having an agent's server that comprises:

a response measurement module, said response measurement module counting the number of specific responses made at a web site of an advertiser through an ad space of a network medium; and

an administration module, said administration module making a statistical report for analysis of the counted responses and delivering said statistical report through said agent's server to the advertiser so that the advertiser can estimate the effectiveness of an advertisement on said network,

wherein said web site includes an entrance page which is linked from said ad space, an action page which is linked from the entrance page and where a user of said network may proceed to make at least one specific action of defined responses to be made by the user as a consequence of the advertisement on said network, and an action process module which responds to said specific action for processing the same,

wherein said administration module produces said statistical report listing a page access number that is the number of the accesses to the entrance page of said web site during a predetermined period of time, an action access number that is the number of accesses to said action page, and a result number that is the number of actions made in response to an action object for necessitating processing at said action process module, and

wherein said statistical report includes a proceeder rate, which is the ratio of the action access number to said page access number, and a completer rate, which is the ratio of the result number to said page access number.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Matsumoto	US 6,763,334 B1	Jul. 13, 2004
Gerace	US 5,848,396	Dec. 8, 1998
Domine	US 5,949,419	Sep. 7, 1999

The following rejections are before us for review:

1. Claims 25-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 5, and 7-12 of Matsumoto.
2. Claims 25-39 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gerace and Domine.

ISSUES OF LAW

The first issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 25-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 5, and 7-12 of Matsumoto.

The second issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 25-39 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gerace and Domine. The issue turns on whether Gerace discloses or would lead one of ordinary skill in the art to a system having a server comprising a response measurement module having the features set forth in claim 25.

PRINCIPLES OF LAW

Obviousness-type double patenting

A one-way determination of obviousness is needed to resolve the issue of double patenting where the application at issue is the later filed application. *See, e.g., In re Berg*, 140 F.3d 1428, 1432 (Fed. Cir. 1998).

> Generally, an obviousness-type double patenting analysis entails two steps. First, as a matter of law, a court construes the claim in the earlier patent and the claim in the later patent and determines the differences. *Georgia-Pacific Corp. v. United States Gypsum Co.*, 195 F.3d 1322, 1326, 52 USPQ2d 1590, 1593 (Fed. Cir. 1999). Second, the court determines whether the differences in subject matter between the two claims render the claims patentably distinct. *Id.* at 1327, 52 USPQ2d at 1595. A later claim that is not patentably distinct from an earlier claim in a commonly owned patent is invalid for obvious-type double patenting.

Eli Lilly & Co. v. Barr Labs., Inc., 251 F.3d 955, 968 (Fed. Cir. 2001).

Obviousness

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the

prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.") The Court in *Graham* further noted that evidence of secondary considerations "might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." 383 U.S. at 17-18.

ANALYSIS

Obviousness-type double patenting

The Appellants have not challenged the substance of the Examiner's rejection of claims 25-39 under the judicially-created doctrine of obviousness-type double patenting. Rather, the Appellants have requested that "the requirement for a Terminal Disclaimer [be held in abeyance] until all other rejections under prior art have been addressed, and that the Examiner reevaluate the requirement for a Terminal Disclaimer at that time." App. Br. 8. Such a request suggests the Appellants have conceded the merits of the underlying obviousness-type double patenting rejection.

For the foregoing reasons, the rejection is affirmed.

Obviousness

Claim 25 is an apparatus claim. It defines a system having a server that comprises (a) a response measurement module and (b) an administration module.

The Examiner cited Gerace as evidence that the prior art discloses the response measurement module of the claimed system. Answer 4-5 ("Gerace

teaches … a response measurement module (*User Objects 37d*, *37e* and *37f*, col. 6 lines 41 to col. 7 line 22) counting the number of specific responses made at web server *27* running program *31* (col. 3 lines 57-62), which reads on at a web site of an advertiser through an ad space (*banners*, col. 8 line 13-15 and Appendix I, esp. col. 23 lines 18-20) of a network medium").

The Appellants argued that Gerace does not teach a response measurement module. The Appellants challenge the Examiner's view that Gerace's program 31 equates to the advertiser web site of the claimed system. Reply Br. 4

> There is no suggestion in Gerace that program 31 is accessed through an ad space, or that it is a website of an advertiser. Nowhere in Gerace is any suggestion made of monitoring user activity at the website of an advertiser; the only monitoring taught by any portion of Gerace is at program 31. Thus Gerace fails to teach or suggest the claimed response measurement module.

Id.

The scope and content of Gerace is therefore at issue. Specifically, does Gerace disclose the claimed response measurement module as the Examiner has indicated?

Gerace describes a system for displaying customized agate information to a computer user and tracking user activity. See col. 2, ll. 3-15. Gerace's system comprises a software program 31 (see Fig 2) residing on a server. Program 31 generates customized home web pages. "During the user's first visit, the initial screen view provides menu selections of various agate information (e.g., stock market data, weather, sports, etc.) Upon user selection (using a click of a mouse or other input means) of a

menu item, program 31 displays corresponding up-to-date information." Col. 4, ll. 4-9. "[F]or each user the present invention program 31 creates a user profile from the agate information viewing habits of the user. The system then generates a custom Home Page, including a user's preferred (content and presentation) agate information." Col. 4, ll. 21-26.

Gerace's system permits sponsors to better direct their advertisements to a user by displaying ads customized to the user's preferences due to the information tracked and recorded by program 31. Col. 4, ll. 29-36. This is accomplished via an agate data assembly 71, user profiling member 73, an advertisement module 75 and program controller 79 (Fig. 2); these are parts of program 31. Col. 4, ll. 36-43.

In operation, the user profiling member 73 of Gerace's system "records information regarding each user, including a user's identification, categories of interest and the user's display preferences of each category." Col. 4, ll. 42-44. Agate data assembly 71 stores agate information for the user to view. Col. 4, ll. 39-40.

> [A]ccording to records in the user profiling member 73, the program controller 79 obtains preference information for that user and using agate information from the agate data assembly 71 generates an initial screen view formatted according to the user's recorded preferences. Program controller 79 transmits the generated screen view … for display to the user.

Col. 4, ll. 60-65. "With respect to the advertisement module 75, program controller 79 obtains sponsor submitted advertisements from module 75 and generates a screen view formatted according to user preferences as determined from the psychographic profile in the user profiling member 73."

Col. 5, ll. 15-19. These advertisements may be displayed as banners incorporated in the resulting customized home page. See col. 8, ll. 13-15.

Gerace's system not only seeks to display customized agate information, including customized advertisements, to a computer user, it also allows for the recording performance data for the displayed advertisement. Gerace explains:

> In addition, for each advertisement, advertisement module 75 … records (a) the number of times and/or number of users to whom the advertisement has been displayed, (b) the number of times/users who have requested more information (via a click of a mouse on a corresponding menu selection) regarding the advertisement, and when possible (c) the number of purchases obtained through program 31's display of the advertisement. As such, advertisement module 75 holds performance data for each advertisement, and hence enables program controller 79 to provide performance reports to sponsors who log on to program 31.

Col. 5, ll. 27-37. Gerace describes the advertisement module in greater detail in discussing the preferred embodiment, i.e., when "program 31 is implemented as an object oriented program" (col. 5, ll. 41-42; referring to Figs. 3a-5b). "A set of Sponsor Objects 33 provides the functional equivalent of the advertisement module 75 of FIG. 2." Col. 5, ll. 57-59. "Referring back to FIG. 3*a*, a set of Sponsor Objects 33 stores sponsor provided information, including advertisements desired to be displayed and details regarding the same." Col. 11, ll. 57-59.

> Another part of the Sponsor Objects 33*a-d* is a computer subroutine 41 (FIG. 3*a*) which provides performance reporting. This enables the

> sponsors of the advertisements to obtain reports on successful use of the advertisements. The types of reports provided in the preferred embodiment of program 31 are outlined in Appendix IV. In that Appendix, "HTs" means hits and "CTs" means click throughs.

Col. 12, ll. 57-63. Appendix IV lists "HTs [Hits] purchased and achieved" (col. 33, l. 48), suggesting that program 31, via the advertisement module's performance reporting, can be made to report on the number of hits on a customized ad presented on a screen displayed to a user. This is further supported by disclosure at col. 15, ll. 27-30 where Gerace discusses profiling of advertisements: "program 31 tracks demographic and/or psychographic criteria of users who view ("hit") and/or select (i.e., "click through") advertisements."

Based on our review of Gerace, as discussed above, we find that it does not disclose the response measurement module defined in claim 25.

While Gerace teaches a program comprising an advertisement module which would appear to be able to function so as to track hits on an advertisement situated on a web page, Gerace does not disclose a module which counts responses made at a web site, of the type claimed, via an ad space on the network. According to claim 25, the response measurement module counts "the number of specific responses made at a web site of an advertiser through an ad space of a network medium." Later in claim 25, the web site is defined as

> include[ing] [1.] an entrance page which is linked from said ad space, [2.] an action page which is linked from the entrance page and where a user of said network may proceed to make at least one specific action of defined responses to be made by

> the user as a consequence of the advertisement on said network, and [3.] an action process module which responds to said specific action for processing the same.

Accordingly, the response measurement module of the claimed system functions so as to count responses made at an advertiser's web site which includes (1) an entrance page linked from an ad space on a network, (2) an action page linked from the entrance page and where a user of the network may proceed to make an action of defined responses as a consequence of the advertisement on said network, and (3) an action process module responding to the action of defined responses as a consequence of the advertisement on said network, via the ad space on the network. To establish a prima facie case of obviousness, the cited prior art must show or lead one of ordinary skill in the art to a system comprising such a response measurement module.

At best, Gerace shows a program recording hits on an ad on a web page. However, the system as claimed requires the response measurement module to count responses made at a web site that is reached *via the ad* and further requires the web site whose responses are counted to include 1) an entrance page linked from an ad space on a network, (2) an action page linked from the entrance page and where a user of the network may proceed to make an action of defined responses as a consequence of the advertisement on said network, and (3) an action process module responding to the action of defined responses as a consequence of the advertisement on said network.

The Examiner directed attention to User Objects 37d, 37e, and 37f, described at col. 6 lines 41 to col. 7 line 22 of Gerace, as evidence that

Gerace discloses a response measurement module (see *supra*, Answer 4-5). However, User Objects 37d, 37e, and 37f provide functionality for the user profiling member 73 (col. 54-55, referring to Fig. 2). These objects are used by Gerace's system to identify users and maintain a user profile. Col. 5, ll. 63-65. These objects do not count responses made at a web site that is reached via an ad, let alone count responses made at a web site as defined in claim 25. While the Examiner indicates that Gerace discloses ad banners at col. 8, ll. 13-15 and Appendix I (col. 23, ll. 18-20), these disclosures describe Gerace's ability to provide customized ads, not the ability to use those ads to reach a web site at which responses are counted. Appendix I, for that matter, simply lists the format of a "'Travel Options Page'" (see col. 9, ll. 16-17.

Accordingly, we agree with the Appellants that, contrary to the Examiner's finding, Gerace does not disclose the response measurement module of the system set forth in claim 25. We reach the same conclusion as to claims 26-35, 38, and 39 which depend on claim 25. The same response measurement module is set forth in system claim 36 and, presented in terms of a method step, in claim 37. Accordingly, we reach the same conclusion as to these claims.

The Examiner has not further articulated a reason with some rational underpinning why, notwithstanding that Gerace does not explicitly disclose the response measurement module of the claimed subject matter, one of ordinary skill in the art would nevertheless have been led to a system comprising such a module given what the cited prior art discloses. As a result, we find that a prima facie case of obviousness for the claimed subject

matter over the cited references has not been made out and we therefore reverse the rejection.

CONCLUSIONS OF LAW

We conclude that the Appellants have *not* shown that the Examiner erred in rejecting claims 25-39 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 5, and 7-12 of Matsumoto.

We conclude that the Appellants have shown that the Examiner erred in rejecting claims 25-39 under 35 U.S.C. § 103(a) as being unpatentable over Gerace and Domine.

DECISION

The decision of the Examiner to reject claims 25-39 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2008).

AFFIRMED

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